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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,622	01/27/2004	Anthony Hermann van Zuilekom	1391-48300	1354

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EXAMINER

NEUDER, WILLIAM P

ART UNIT

PAPER NUMBER

3672

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,622

Applicant(s)

VAN ZUILEKOM ET AL.

Examiner

William P. Neuder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/30/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2,4,7,9,14,16,17,20,22,25,27,36,38 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 states that the retainer engages the entire perimeter. The entire perimeter has not been defined in the specification and the claim must define the entire perimeter. None of applicant's embodiments seem to engage the entire perimeter. The entire perimeter would be the entire outer surface of the seal pad. Even if Applicant defined the axis, none of the retainers seem to engage the entire perimeter. Looking at figure 5A, the entire perimeter along the X-axis would include the beveled portion of the seal that is not engaged by the retainer. Claim 4 states that the expansion cavity is located around the entire perimeter. Clearly from figure 5D, the cavity is not around the entire perimeter and even does not meet the limitation of entire perimeter if defined with respect to an axis. All of these claims contain some reference to the entire perimeter. Clarification of these claims is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3,5,6,8,10,11,13,15,18,19,21,23,24,26,28,29,32,35,37,40 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Bretzke, Jr. 4173485.

Bretzke discloses a seal pad 44. The pad includes a base plate 36 having an expandable material 44 attached to the base plate. The expandable material 44 comprises an outer surface suitable for sealing against a borehole wall (figure 2A). The expandable material is expanded during the sealing of the device against the wall. A retainer 58 helps control the expansion of the material 44. The retainer engages a portion of the outer surface of the seal, since the bottom of the seal is part of the outer surface. As to claims 3,15,21 and 37, an expansion cavity is defined between the seal and the retainer 58 into which the expandable material expands (see fig. 2B). As to claims 5 and 23, the retainer is integrated with the base plate. Integrated means to form into a united or whole piece. Retainer 58 is bolted onto plate 36 to form a united piece. As to claims 6 and 24, the portion of retainer 58 that extends into contact with the seal is considered a rib of the base plate since the retainer and base plate are connected into a single structure. As to claims 8,18,26 and 40, the retainer controls expansion in the lateral and radial directions. As to claims 10,11,28 and 29, the expandable material is rubber, rubber being an elastomeric material. As to claim 13, the method comprises controlling expansion by use of the retainer when the sealing pad is sealed against the wall. As to claim 19, the tool includes an extendable probe a flow path 46 extending through the seal pads. A fluid collection chamber is provided. Means 46 transfers the fluid from the formation into the collection chamber (see fig. 3A). As to claims 32 and

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44, the tool is lowered into the well by a wireline 14. As to method claim 35, the tool is lowered and the probe extended while controlling expansion and a formation fluid sample is taken with the tool.

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 12 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bretzke, Jr. (described above).

It would have been considered an obvious design choice to form the seal pads from Teflon since Teflon seals are well known and any sealing material capable of

withstanding the wellbore environment could be used as the material for forming the seal pads.

Claims 33,34,42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bretzke, Jr. (described above) in view of Hill et al 2005/0155760.

As to claims 33 and 42, Bretzke does not teach that the tool can be lowered on a drill string. Hill teaches that his sampling tool (which is substantially identical in operation to the tool of Bretzke) can be used after drilling (fig. 3) or while drilling (fig. 4). It would have been considered obvious to use the device of Bretzke while drilling in view of Hill's teaching that sampling probes can be used both after and during drilling. As to claim 34, Hill also teaches that it is known to provide pumps to withdraw the sample. It would have been considered obvious to provide Bretzke with a pump for removing the sample as taught by hill since the use of a pump allows better control of the time required to take the sample. As to claim 43, the drilling must be stopped in order to take the sample in Hill.

Claims 31,41 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bretzke, Jr. in view of Fox et al 2004/0173351.

Bretzke (described above) does not provide a sensor. Fox teaches that it is known to provide sensors for sensing formation characteristics in a sampling tool. It would have been considered obvious to provide Bretzke with a sensor as taught by Fox so that real time indications of formation characteristics may be ascertained. As to claim 45, Fox teaches transmitting the sensor signal to the surface by telemetry.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Neuder whose telephone number is 571-272-7032. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William P Neuder
Primary Examiner
Art Unit 3672

W.P.N.